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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,090	02/06/2004	Devlin A. Hunt	1102285	2089
27062	7590	10/03/2007	EXAMINER	
OSLER, HOSKIN & HARCOURT LLP (BRP2) 2100 -1000 DE LA GAUCHETIERE ST. WEST MONTREAL, H3B4W5 CANADA			VASUDEVA, AJAY	
			ART UNIT	PAPER NUMBER
			3617	
			MAIL DATE	DELIVERY MODE
			10/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/708,090

Applicant(s)

HUNT ET AL.

Examiner

Ajay Vasudeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 15, 17, 18, 23-28, 30-33, 35-39, 43 and 46 is/are rejected.
- 7) ☒ Claim(s) 14, 16, 19-22, 29, 34, 40-42, 44 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 1-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 5/17/2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30, 31, 36 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-220213 A ('213).

JP ('213) shows an outboard motor comprising an engine [6] disposed within a housing [10], wherein housing has upper and lower portions [10a, 10b]. Upper and lower cavities are formed between upper and lower portions of the housing and the engine, respectively. An oil container [8] is disposed in the lower cavity that is formed between the engine and the lower portion of the housing. A pump [26] is enclosed in the oil container (see fig, 14).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12, 13, 15, 23-28, 30, 31, 36, 39, 43 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US 6,053,785 A) in view of Hartke et al. (US 6,477,992 B2).

Kato et al. shows an outboard motor comprising a two-stroke direct fuel injected engine [16] surrounded by a housing cover (see fig. 2). The outboard motor also comprises an oil tank [107] positioned within a cavity formed between the engine and the housing cover (see col. 8, lines 26-32).

Kato et al., however, is silent on the details of the oil tank. Further, Kato et al. does not disclose the provision of an oil pump with the oil tank

Hartke et al. shows an oiling system (fig. 3) for use with an outboard motor having a fuel-injected engine (see abstract, line 1; col. 1, line 27; and col. 3, lines 25-28). The oiling system comprises an oil pump [204] positioned within an oil tank [202] so as to keep the oil warm and thin even in cold weather. The oiling system has a manifold [206] that provides an oil distribution hub with an inlet in fluid communication with the pump and a plurality of outlets. At least one outlet is fluidly connected to the engine (see fig. 3). A pressure sensor is connected to an ECU and an outlet of the pump to indicate and allow control of the oil pressure from the pump (see col. 3, lines 50-65).

It would have been obvious for one skilled in the art at the time of the invention to provide an oiling system in the outboard motor of Kato et al., as taught by Hartke et al. Having such a system would have allowed the oil to stay warm and thin even in the cold weather,

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thereby allowing the oil to be easily pumped out through the oil supply line and preventing costly damage to engine cylinders.

Re claim 23, it would have been obvious for one skilled in the art at the time of the invention to size the oil tank according to the engine size. Further, if the engine were to be used sporadically, the oil tank would be capable of holding an average year's supply of oil. Re claim 24, one skilled in the art would have known to design the oil tank to have a 0.02 Liter/HP to 0.05 Liter/HP capacity.

6. Claims 17, 18, 32, 33, 35, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US 6,053,785 A) in view of Hartke et al. (US 6,477,992 B2), and further in view of Abe et al. (US 4,766,860 A).

Kato et al., as modified above by Hartke et al., shows an outboard motor comprising an oil pump disposed within an oil tank.

Modified Kato et al., however, does not disclose the structure or the attachment mechanism of the oil tank.

Abe et al. shows an oil tank [151] having a float [174] (see fig. 2 and fig 6). The oil tank is considered as having a generally L-shape with longitudinal/vertical and lateral sections, and an opening [49] in the lateral section that is capable of functioning as a filler opening. A second opening with a cap [43] is provided in the longitudinal/vertical section. The longitudinal/vertical portion further comprises a pair of bosses vertically offset from one another for mounting the oil container to the engine. A depth of the longitudinal/vertical portion is greater than a length of the lateral portion. The oil tank has a filter for filtering lubricant to the engine and is capable of

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sensing a clogged filter condition. In addition, a sensing device also provides an indication of the level of lubricant within the oil tank.

It would have been obvious for one skilled in the art at the time of the invention to provide an oil tank in the outboard motor of modified Kato et al., as taught by Abe et al.. Having such an oil tank would have allowed the tank to be mounted directly on the engine body, and would have provided an oil reservoir that had a filter for filtering lubricant to the engine and was capable of sensing a clogged filter condition.

Re claim 17, Applicant may note that claim is being treated as product claims. However, the limitation "oil tank is constructed of two molded halves, joined by a weld" is a product by process limitation. Therefore, the process by which the oil tank is made is not given weight in the product claims (MPEP 2113).

Allowable Subject Matter

7. Claims 14, 16, 19-22, 29, 34, 40-42, 44 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record in the attached PTO Form 892, but not yet relied upon, is considered pertinent to applicant's disclosure.

- JP 09-125926 A shows a pump enclosed in an oil container.

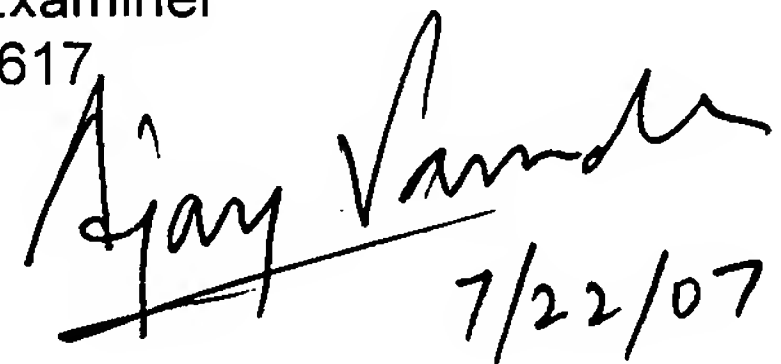
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ajay Vasudeva
Primary Examiner
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7/22/07